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10/526,199

03/01/2005

Gerard Cnossen

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS  
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EXAMINER

PENG, KUO LIANG

ART UNIT

PAPER NUMBER

1712

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|-----------|---------------|
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3 MONTHS

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/526,199

Applicant(s)

CNOSSEN ET AL.

Examiner

Kuo-Liang Peng

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10/26/05 IDS.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 2-4, 6, 7 and 9-14 is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/26/05.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The Applicants' preliminary amendment filed March 1, 2005 is acknowledged. Claims 3-5, 7-8, 10 and 14 are amended. Now, Claims 1-14 are pending.

#### ***Claim Objections***

2. Claims 2-4, 6-7 and 9-14 are objected to because of the following informalities:

In Claims 2-4, 6-7 and 9-14, Applicants are advised to replace "characterized in that" with—wherein --.

In Claim 2 (lines 1-2), Applicants are advised to replace "hydroxypropylmethylcellulose (HPMC) is used as cellulose derivative" with—the cellulose derivative is hydroxypropylmethylcellulose (HPMC) --.

In Claims 3-4, Applicants are advised to make similar amendments as in Claim 2 above.

In Claims 10-14, Applicants are advised to replace "it" with—said substrate --.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 1 (line 1), should "Compound" be—A composition—because the claim is directed to more than one compound.

In Claims 2-4 (line 1), should "Compound" be—The composition --?

In Claim 4 (line 2), should "compound" be—composition --?

In Claim 4 (line 1), "as claimed" caused confusion because it is not clear as to which claim it depends to.

In Claim 5 (line 1), should "Screen-printed" be—A screen-printed --?

In Claims 6-7 (line 1), should "Screen-printed" be—The screen-printed --?

In Claim 8 (line 1), should "Substrate" be—A substrate --?

In Claims 9-14 (line 1), should "Substrate" be—The substrate --?

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-5 and 7-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Rouquier (WO 01/23639).

The following column and line numbers are based on Rouquier's U.S. equivalent, US 6 656 607.

For Claims 1-4, Rouquier discloses a coating composition containing a hybrid sol-gel precursor, particles and as a thickener, a cellulose. The cellulose can be hydroxypropylmethylcellulose. (col. 1, lines 24-29, col. 2, line 54 to col. 3, line 41 and col. 4, lines 29-39) The preamble "suitable for screen-printing" is merely an intended use, and does not carry any weight of patentability. Alternatively, since the composition reads on the claimed one. As such, it should inherently be suitable for screen-printing. For Claims 5 and 7, Rouquier is silent on a layer prepared by screen-printing method. However, these claims are Product-by-Process claims. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different

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process” In re Thorpe, 777 F. 2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Since the composition reads on the claimed one, the layers derived therefrom should inherently have the same density. For Claims 8-14, Rouquier teaches the use of the composition for coating metal substrates. (Abstract) Furthermore, since the composition reads on the claimed one, it should be suitable for coating the claimed substrates set forth in the instant claims.

### *Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rouquier.

Rouquier discloses a coating composition, *supra*, which is incorporated herein by reference.

For Claim 6, Rouquier is silent on the specific claimed layer thickness. However, the layer thickness can affect the durability of the coating. In other

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words, the layer thickness is a Result-Effective variable. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to apply a layer with whatever thickness through routine experimentation in order to afford a layer with desired durability. Especially, Applicants do not show the criticality of the layer thickness. See MPEP 2112.01

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->

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direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp

January 31, 2007

  
Kuo-Liang Peng  
Primary Examiner  
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